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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant(s) : Miller et al.

Serial No. : 09/181,108

Filed : October 28, 1998

For : COMBINATORIAL LIBRARIES

Examiner:
T. C. McCarthy

Art Unit:
1618

Assistant Commissioner for Patents
Washington, D.C. 20231

Box:

Sir:

Transmitted herewith is a **Response to Restriction Requirement** (2 pages) in the above-identified application. Also enclosed are:

- ☐ A Request for ____-Month Extension of Time.
- ☒ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27.
- ☒ A self-addressed, prepaid postcard for acknowledging receipt.
- ☒ No additional fee is required.
- ☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	a) SMALL ENTITY b) LARGE ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADD'L FEE
TOTAL	*40	MINUS	**40	+ x	a) \$ 9= b) \$18	\$ 0.00
INDEP	*1	MINUS	***1	+	a) \$39= b) \$78	\$ 0.00
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					see fee schedule	\$
<input type="checkbox"/> Extension of Time Fee (____ Months)						
TOTAL						\$ 0.00

- * If the entry on Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- ** If the "Highest Number Previously Paid For" IN THIS SPACE in less than 20, write "20" in this space.
- *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.


The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

☐ A check for \$_____ is enclosed to cover the above fees.

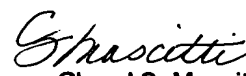
☒ The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 14-1138.

A duplicate copy of this sheet is enclosed.

Date: January 6, 2000


Georgia Caton
Registration No. 44,597

NIXON PEABODY LLP
Clinton Square, P.O. Box 1051
Rochester, New York 14603
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Certificate of Mailing - 37 CFR 1.8(a)	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below.	
<u>1-6-2000</u> Date	 Cheryl S. Mascitti



PATENT
Docket No.: 176/60440 (1-110334-704)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#10
JRP
4/17/00

Applicants	:	Miller et al.)	Examiner:
)	T.C. McCarthy
Serial No.	:	09/181,108)	
)	Art Unit:
Filed	:	October 28, 1998)	1618
)	
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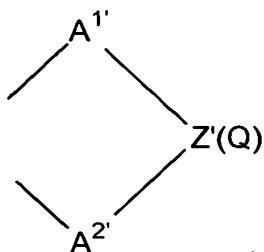
RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

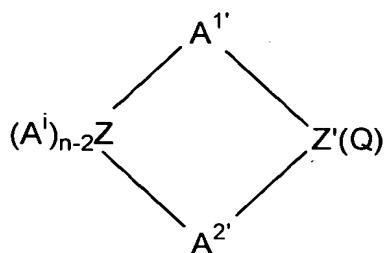
Dear Sir:

In response to the December 7, 1999, written restriction requirement, applicants hereby elect the invention of Group I (claims 1 to 10, drawn to a combinatorial library), with traverse. However, applicants submit that this restriction requirement does not meet the standards of 35 U.S.C. § 121 and, therefore, should be withdrawn. In particular, each of the inventions of Groups I to IV includes the subject matter of claim 1. It is, therefore, not understood how these groups can be separate and distinct. Applicants submit that there is no benefit derived from maintaining the restriction requirement with regard to Groups I to IV in that election of any one of these groups requires that a search for the subject matter of claim 1 be conducted. Moreover, consideration of the patentability of claim 1 would not be proper without consideration of the subject matter of all the inventions of Groups 1 to IV. Since there is no benefit in maintaining the present restriction requirement, applicants submit that it should be withdrawn.

Having elected the claims of Group I, applicants, as required by the outstanding office action, elect the following species: A¹ and A², taken together, have the formula:



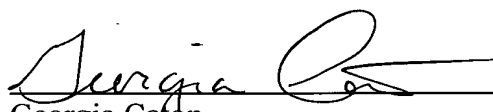
where $A^{1'}$ and $A^{2'}$ are pluridentate non-biopolymer ligands, Z' is a second complexing agent identical to or different than Z , and Q is one or more non-biopolymer ligands so that $Z(A^1)(A^2)(A^i)_{n-2}$ has the formula:



with traverse. Claims reading on the elected species include claims 1-3 and 6-10.

Respectfully submitted,

Date: January 6, 2000


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Registration No. 44,597

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